

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF WASHINGTON

CORPORATION OF GONZAGA)
UNIVERSITY,) NO. CV-14-0093-LRS
Plaintiff,) **ORDER GRANTING GONZAGA'S**
-vs-) **MOTION FOR PERMANENT**
PENDLETON ENTERPRISES, LLC,) **INJUNCTION**
a Washington LLC; PENDLETON)
BROADCASTING, INC., a)
Washington Corporation; and)
JAMIE PENDLETON, an)
individual and a resident of)
the State of Washington,)
Defendants.)

BEFORE THE COURT is Plaintiff Corporation of Gonzaga University's ("Gonzaga") Motion For Entry of a Permanent Injunction Order, ECF No. 34, filed on October 22, 2014 and argued on December 10, 2014 in Yakima, Washington.

Plaintiff Gonzaga filed its Motion for Summary Judgment on July 16, 2014. After briefing, oral argument was held on

1 September 4, 2014. On September 25, 2014, the Court entered
2 its Order on Gonzaga's Motion for [Partial] Summary Judgment
3 (ECF No. 33), granting Gonzaga's motion which the Court hereby
4 incorporates by this reference into this Permanent Injunction.
5 In its order granting summary judgment, the Court
6 found that Defendants' conduct violated §43(a) [15 U.S.C.
7 §1125(a)] of the Lanham Act through the Defendants' use of
8 Gonzaga's Identifiers and Trademarks.

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11 The Court finds that Plaintiff Gonzaga is the owner of the
12 Gonzaga Identifiers and Trademarks as defined below, which
13 have achieved secondary meaning through their use in the
14 Spokane, Washington area. In the Spokane area, Gonzaga's
15 Identifiers and Trademarks are commercially strong and there
16 is no dispute that each of the Gonzaga Identifiers and
17 Trademarks refer to or identify Gonzaga in the Spokane area.
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20 The Defendants commercial use of the Gonzaga Identifiers
21 and Trademarks have the potential to cause confusion in the
22 minds of consumers about the origin of the goods or services
23 in question or a sponsorship, approval or affiliation by
24 Gonzaga that doesn't exist. The Court concludes that use of
25 the Gonzaga Identifiers and Trademarks creates a likelihood of
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1 confusion between Defendants' goods and services and Gonzaga.

2 The Lanham Act gives the Court "power to grant injunctions
3 according to the rules of equity and upon such terms as the
4 court may deem reasonable, to prevent the violation" of a mark
5 holder's rights. 15 U.S.C. § 1116(a); *Pepsico, Inc., et al. v.*
6 *Cal. Sec. Cans*, 238 F.Supp.2d 1172, 1177-78 (2002).

7 A permanent injunction may be entered where the plaintiff
8 shows: (1) that it has suffered an irreparable injury; (2)
9 that remedies available at law, such as monetary damages, are
10 inadequate to compensate for that injury; (3) that,
11 considering the balance of the hardships between the plaintiff
12 and defendant, a remedy in equity is warranted; and (4) that
13 the public interest would not be disserved by a permanent
14 injunction.

15 While "[t]he decision to grant or deny permanent
16 injunctive relief is an act of equitable discretion by the
17 district court," the "traditional principles of equity" demand
18 a fair weighing of the factors listed above, taking into
19 account the unique circumstances of each case. *Ebay, Inc. v.*
20 *Mercexchange, L.L.C.*, 547 U.S. 388, 395 (2006).

21 In considering injunctive relief, the Court finds that

1 Gonzaga has suffered irreparable injury to its goodwill
2 and will suffer further irreparable injury if
3 Defendants' conduct which this Court has found to violate
4 §43(a) [15 U.S.C. §1125(a)] of the Lanham Act is allowed to
5 continue. This irreparable injury includes, without
6 limitation: 1) Gonzaga is unable to control use of the
7 Gonzaga Identifiers and Trademarks; 2) Gonzaga is unable
8 to control or approve the nature of the business or
9 commercial enterprise that is being promoted with Gonzaga
10 Identifiers and Trademarks; 3) Gonzaga is unable to control
11 the type of event or services promoted in connection with the
12 use of the Gonzaga Identifiers and Trademarks; 4) Gonzaga is
13 unable to prescribe and control the conduct of the Gonzaga
14 mascot wearing a Gonzaga identifying jersey; and 5) Gonzaga,
15 a Jesuit Catholic University, cannot control the negative
16 public perception and impact resulting from confusion that it
17 is affiliated, connected, or associated with Defendants'
18 businesses.

23 In considering injunctive relief, the Court further finds
24 that the full scope of the past and future harm to Gonzaga's
25 reputation is and would be difficult to quantify and difficult
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1 to convert to monetary damages. Therefore, monetary damages
2 would be inadequate to compensate for injury that would
3 result from Defendants' continued use of Gonzaga's Identifiers
4 and Trademarks.

5 The Court further finds that the balance of hardships of
6 the entry of a permanent injunction favors Gonzaga, as the
7 Court notes that Defendants are not presently conducting
8 businesses in the bar and radio enterprises but have not
9 abandoned plans to do so in the future. Finally, the Court
10 finds that the public interest is served by the removal
11 of the creation of a likelihood of confusion that Defendants
12 are affiliated, connected or associated with Gonzaga, or that
13 there was a sponsorship or approval by Gonzaga of Defendants'
14 goods, services, or commercial activities, when there is no
15 such connection, association or affiliation.

16 Good cause exists to enter a permanent injunction. Based
17 upon the facts, evidence and the Court's Order on Gonzaga's
18 Motion For [Partial] Summary Judgment (ECF No. 33) finding
19 that Defendants' conduct violated §43(a) [15 U.S.C. §1125(a)]
20 of the Lanham Act through Defendants' use of Gonzaga's
21 Identifiers and Trademarks, Plaintiff Gonzaga's Motion for
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1 Entry of A Permanent Injunction, **ECF No. 34**, is hereby
2 **GRANTED**. Accordingly,

3 (1) Judgment is entered in favor of Plaintiff and against
4 Defendants on the first cause of action only (Violation of the
5 Lanham Act, 15 U.S.C. §1125(a)).¹

6 (2) A permanent injunction order is hereby issued pursuant
7 to Rule 65 of the Federal Rules of Procedure to restrain and
8 enjoin Defendants Pendleton Enterprises, LLC, Pendleton
9 Broadcasting Inc., and Jamie Pendleton (collectively referred
10 to as "Defendants") as well as each of their agents, servants,
11 employees, attorneys, and all those in active concert with them
12 from:

13 (a) displaying, advertising, marketing, promoting,
14 stating or suggesting affiliation with, or otherwise using in
15 commerce, or contributing to the use of in commerce, any of
16 Gonzaga's Identifiers and Trademarks, as defined below, or
17 using or contributing to the use in commerce any goods,
18 products, or tangible property bearing any of the Gonzaga's
19 Identifiers and Trademarks;

20 ¹Plaintiff amended the complaint to delete all remaining claims in
21 the original complaint. Order Granting Motion to Amend (ECF No. 47).

1 (b) engaging in any activity that misleads or confuses
2 or is likely to mislead or confuse the public to the detriment
3 of Gonzaga, including (without limitation) any activity
4 that constitutes a violation of 15 U.S.C. § 1125(a)(1);

5 (c) using or displaying the Bulldog Mascot with a
6 Gonzaga identifying jersey, in connection with Defendants'
7 current and future business or commercial interests, or goods
8 or services;

9 (d) using or displaying the Bulldog Mascot with a
10 Gonzaga identifying jersey, in connection with the promotion
11 of third party businesses or commercial enterprises;

12 (e) using or displaying of Gonzaga Identifiers and
13 Trademarks on or in combination with Defendants' vehicles used
14 to promote any business or commercial interests, or goods and
15 services, of the Defendants, including without limitation,
16 defendants' radio station 104.5 or bar services;

17 (f) using Gonzaga Identifiers and Trademarks in a way
18 which is likely to cause confusion, or to cause mistake, or to
19 deceive as to the affiliation, connection, or association
20 of Defendants' businesses, or as to the origin,
21 sponsorship, or approval of Defendants' radio station and bar

1 services, or other current or future business or commercial
2 interests, or goods and services, with or by Gonzaga;

3 (g) engaging in any activity that could or is likely
4 to lead anyone to believe that any product or service has been
5 produced, distributed, offered, advertised, displayed,
6 licensed, sponsored, approved, authorized, or otherwise used
7 in commerce by or for Gonzaga, when such is not true in fact;
8 and/or

9 (h) assisting, aiding, abetting, or contributing
10 to any other person or entity in engaging in or performing any
11 of the activities referred to above.

12 (i) For clarity and without limitation, the
13 Defendants' uses and displays of Gonzaga's Identifiers and
14 Trademarks as evidenced in paragraphs 13-31 of Gonzaga's
15 Statement of Material Fact (ECF 22) are examples of uses of
16 Gonzaga's Identifiers and Trademarks for business or
17 commercial purposes, or in connection with the goods or
18 services of the Defendants.

19 Gonzaga's "Identifiers and Trademarks," as the term is
20 used herein, refers to and includes the following:

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- 1 • "GONZAGA UNIVERSITY", which is the subject of U.S.
2 Trademark Registration No. 1,931,286, and is an
3 incontestable U.S. trademark per 15 U.S.C. §1065.
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- 5 • "GONZAGA UNIVERSITY BULLDOGS", which is the subject of
6 U.S. Trademark Registration No. 1,931,285, and is an
7 incontestable U.S. trademark per 15 U.S.C. §1065.
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- 9 • "ZAGS", which is the subject of U.S. Trademark
10 Registration No. 1,931,449, and is an incontestable
11 U.S. trademark per 15 U.S.C. §1065.
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- 13 • Gonzaga's "Bulldog mascot wearing a Gonzaga jersey",
14 which the record indicates that Gonzaga has used in
15 Spokane since the 1980's, and which is the subject of
16 Washington State Trademark Registration File No.
17 56807.
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- 19 • Gonzaga's Bulldog Head, for which Gonzaga has been
20 awarded Washington State Trademark Registration File
21 No. 56780, showing a date of first use in Washington
22 in 1998.
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- 24 • Gonzaga's Bulldog Head combined with the word Gonzaga,
25 for which Gonzaga has been awarded Washington State
26 Trademark Registration File No. 56959, showing a date

1 of first use in Washington in 1998.

2 • Gonzaga's Identifier "GU", for which Gonzaga has been
3 awarded Washington State Trademark Registration File
4 No. 56960, showing a date of first use in Washington
5 in 1998.

6 • Gonzaga's Bulldog Head combined with "GU", for which
7 Gonzaga has been awarded Washington State Trademark
8 Registration File No. 56958, showing a date of first
9 use in Washington in 1998.

10 (3) Defendants are further ordered to destroy and/or turn
11 over to counsel for Plaintiff any and all material,
12 merchandise, and/or items in their care, custody or control
13 bearing any of the Gonzaga's Identifiers and Trademarks.

14 (4) Pursuant to 15 U.S.C. §1116, the Defendants are
15 further ordered, to file with the Court and serve upon the
16 Plaintiff, an affidavit confirming compliance with injunctive
17 relief awarded by the court herein, by, without limitation,
18 removing all Gonzaga Identifiers and Trademarks from
19 Defendants' advertising and promotional materials (including
20 website and social media), and have removed all Gonzaga
21 Identifiers and Trademarks from Defendants' vehicles promoting

Defendants' business and commercial interests, or goods or services. Accordingly,

The District Court Executive is directed to enter this Order; enter judgment consistent with this Order; and **CLOSE THIS FILE.**

DATED this 8th day of January, 2015.

s/Lonny R. Suko

LONNY R. SUKO
SENIOR UNITED STATES DISTRICT JUDGE